

REMARKS/ARGUMENTS

The above-identified patent application has been reviewed in light of the third supplemental Examiner's Answer dated September 16, 2008 wherein Claim 10 has been rejected as being obvious in view of a combination of Lewis, Ball and Oropallo. In view of the new claims presented above and the arguments presented below, Applicant respectfully submits that the claims are in condition for allowance.

Claims 1-9 were previously cancelled. Claim 10 is cancelled, without intending to abandon or dedicate to the public any patentable subject matter. Claims 11 - 23 have been added. Accordingly, Claims 11- 23 are now pending.

I. New Claims 11-15 and 21-23

Claims 11-23 have been added and are believed to be allowable over the combination of Lewis, Ball and Oropallo. Lewis was cited for disclosing all of the claim limitations "except for the overflow fitting including a diaphragm and cap." Ball was cited for the notion of associating a diaphragm with an overflow fitting. Oropallo was cited for supplying the overflow fitting having a cap. Appellant asserts that Oropallo does not qualify as prior art under 35 U.S.C. §102 and can not be combined with Ball and Lewis under 35 U.S.C. §103. More specifically, Claims 11-15 and 21-23 enjoy a priority date prior to the filing date of Oropallo, therefor the combination of Lewis, Ball and Oropallo is not proper.

A review of the record will show that the instant application is a Continuation-In-Part of U.S. Patent Application Serial Nos. 09/954,420, filed September 17, 2001, now U.S. Patent No. 6,691,411 and 10/229,533 ("the '533 application"), filed August 28, 2002, now U.S. Patent No. 6,675,406, the latter being a Continuation of abandoned U.S. Patent Application No. 09/593,724 ("the '724 application"), filed June 13, 2000. Thus subject matter of the '724 application, commonly disclosed in the manner provided by the first paragraph of 35 U.S.C. §112 in the '533 application and in the instant application, enjoys a priority date of **June 13, 2000**. 37 CFR §1.78. Oropallo was filed March 28, 2002 after the filing date of the '724 application. The cap and nut combination, for which

Oropallo was cited as disclosing, was disclosed at least in Fig. 3 of the '724 application and in Fig. 3 of the '533 application.

The elements of Claims 11-15 and 21-23 can be found in the '724 application, the '533 application and the instant application. Therefore, any claims including such elements are entitled to the benefit of the June 13, 2000 filing date.

A. Continuity of Inventorship

In order for an application to claim an earlier effective filing date there must be continuity of inventorship. That is, each prior-filed application must name as an inventor at least one inventor named in the later-filed application. William T. Ball is the sole inventor of the '724 application, the '533 application and the instant application. Thus the requirement of continuity of inventorship has been met.

B. Continuity of Subject Matter

In order for an application to claim an earlier effective filing date there must be continuity of subject matter. That is, the invention claimed in the later-filed application must have been disclosed in the earlier application(s) from which priority is sought in a manner provided by the first paragraph of 35 U.S.C. §112. Newly presented Claims 11-15 and 21-23, which are supported by the disclosure of the instant application, include subject matter found in the '724 application and '533 application. Claim 11 is presented below with an associated table that directs the Examiner to examples of support for the indicated claim elements in the '724 application and the '533 application.

11. (New) A method of testing a plumbing system associated with a bathtub for leakage, comprising:

providing an overflow pipe with an upper end and a lower end with an elbow therebetween¹, said upper end being adapted to fit at least completely through an overflow port of the bathtub, said upper end extending from an outer surface of the bathtub to the inner surface of the bathtub²;

providing a lip extending radially outwardly from an outer surface of the overflow pipe between the elbow and the upper end³ that is adapted to engage an outer surface of the bathtub adjacent to the overflow port;

associating a nut element⁴ with said upper end of said overflow pipe to secure said overflow pipe within the overflow port of the bathtub, wherein a wall of the bathtub is positioned between said lip and said nut element⁵, said nut element comprising at least one lug extending radially therefrom⁶;

preventing fluid flow through said overflow pipe⁷;

testing the plumbing system associated with said bathtub to determine the existence of a fluid leak⁸;

permitting fluid flow through said overflow pipe⁹; and

engaging a cap to said at least one lug to cover said nut member¹⁰, said cap being detachably engageable to said at least one lug.

Element	Application	Support
1	09/593724	Fig. 3
	10/229533	Fig. 3
	10/732726	Fig. 4
2	09/593724	Fig. 4
	10/229533	Fig. 4
	10/732726	Fig. 1

Element	Application	Support
3	09/593724	Fig. 3
	10/229533	Fig. 3
	10/732726	Fig. 4
4	09/593724	Fig. 4
	10/229533	Fig. 4
	10/732726	Fig. 1
5	09/593724	Fig. 4
	10/229533	Fig. 4
	10/732726	Fig. 1
6	09/593724	Fig. 3
	10/229533	Fig. 3
	10/732726	Fig. 4
7	09/593724	Fig. 4
	10/229533	Fig. 4
	10/732726	Fig. 4
8	09/593724	Page 2 of the application as filed.
	10/229533	Col. 2, Lines 13-17 of the issued patent.
	10/732726	Page 8, Line 30 - Page 9, Line 6 of application as filed.
9	09/593724	Fig. 5
	10/229533	Fig. 5
	10/732726	Fig. 5
10	09/593724	Fig. 4
	10/229533	Fig. 4
	10/732726	Fig. 4

The elements of Claims 12-15 and 21-23 may similarly be found in the '724 application and the '533 application. Applicant will be pleased to provide similar examples of support if required by the Examiner to facilitate prosecution.

C. Cependency

Finally, in order to claim priority, the application making the claim must be entitled to a filing date as set forth in 37 CFR §§ 1.53(b) and § 1.53(d) and have paid the basic filing fee set forth in 37 CFR § 1.16 within the pendency of the parent application.

1. Cependency of the ‘724 application and the ‘533 application

Review of the prosecution history of the ‘724 application will show that an Appeal Brief (“Appeal Brief 1”) was received by the USPTO on February 1, 2002. Thereafter, on February 28, 2002, a Notification of Non-Compliance with 37 CFR §1.192(c) (“Notification 1”) was issued by the USPTO indicating that Appeal Brief 1 did not comply with the rules. Notification 1 set a one-month deadline to respond, March 28, 2002. On March 28, 2002, a second Appeal Brief (“Appeal Brief 2”) was timely submitted in response to Notification 1. A subsequent Notification (“Notification 2”), which indicated that Appeal Brief 2 was non-responsive to Notification 1, was issued by the USPTO on May 17, 2002. After receiving a second non-compliance notification, Applicant decided to address the alleged deficiencies of Appeal Brief 2 by filing the ‘533 continuing application, which later issued as U.S. Patent No. 6,675,406.

The ‘533 application was filed on August 28, 2002, six months from the date of Notification 1. Applicant directs the Examiner’s attention to the Exhibits of the July 30, 2008 Appeal Brief filed in the instant application that show the transaction history of the ‘724 application, and the transaction history of the ‘533 application (both obtained from the USPTO’s Patent Application Information Retrieval system), a family tree of the applications at issue, and other relevant information. In the ‘724 application, Applicant checked the box authorizing payment of any additional fee required under 37 C.F.R. §§1.116 and 1.117. Similarly, such box was also checked when the ‘533 application was filed. 37 C.F.R. §1.136(a)(3) states in relevant part:

“An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this

paragraph for its timely submission.” (Emphasis added).

The ‘533 application, together with its fee authorization, therefore sufficed as a “reply” under the rules to invoke a constructive extension of time.

Such authorization, along with the filing of the ‘533 continuation application, thereby invoked a constructive petition for an extension of time to reply to Notification 1 from March 28, 2002 to the filing date of the ‘533 application, August 28, 2002. Therefore, since the ‘533 application was filed prior to the abandonment of the ‘724 application, the requisite copendency existed in order for the ‘533 application to properly claim domestic priority under 35 U.S.C. §120. Based on this priority date, Oropallo is not an available prior art reference.

Title 37 of the Code of Federal Regulations contemplates that the filing of a continuing application is a “reply”. More specifically, 37 CFR §1.137, specifically states that “in a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application.” 37 CFR §1.137(c) (emphasis added). The ‘533 continuing application addressed the issues set forth in Notifications 1 and 2. Specifically, Applicant filed a preliminary amendment that cancelled original claims 1-9 and added new claims 10-20 in the ‘533 Application in an attempt to overcome the Examiner’s rejection of claims. Furthermore, Applicant’s Preliminary Amendment of the ‘533 Application addressed the obviousness rejection at issue in Appeal Brief 2 and explicitly stated that the claims were placed in “better form,” as compared to those on appeal. The very purpose of the continuation ‘533 application was to reply to the issues raised in the ‘724 application prosecution.

Further, in Notification 1, the Examiner stated that the term “sealing element” used in Claim 1 was not properly amended. The Examiner stated that “while this issue was removed from consideration by the Amendment filed April 30, 2001 (where the offending claim language was cancelled), the Amendment filed September 5, 2001 reinstated such claimed subject matter”. (Emphasis added). This issue was properly addressed in the Preliminary Amendment that accompanied the ‘533 application. More specifically, the ‘533 application was amended to further

describe the sealing element shown in Fig. 4. This description of the drawing provided the required enabling disclosure and was not objected to as adding new matter to the specification.

2. Copendency of the '533 application and the instant application

The instant application was filed December 10, 2003, before the issued date of the '533 application, January 1, 2004. Thus copendency between the '533 application and the instant application existed.

II. Claims 16-20

Although Claims 16-20 are dependent on allowable Claim 11, they include subject matter originally disclosed only in the instant application. Thus Oropallo does qualify as citable prior art as to Claims 16-20. The cited combination, however, does not disclose a testing system that includes, among other things, a selectively sealable overflow assembly and a selectively sealable drain assembly. Applicant submits that Claims 16-20 are allowable since the cited combination of Lewis, Ball and Oropallo does not include each and every one of the elements found in Claims 16-20.

Conclusion

Applicant respectfully traverses the remainder of the Examiner's assertions as to what is disclosed in and/or taught by the cited prior art. That is, since the amendments and arguments presented herein are believed to sufficiently address the rejections, any Examiner assertions not explicitly addressed are not admitted as true. Furthermore, any arguments concerning motivation to combine, etc. not specifically set forth are not waived, and all prior arguments presented during the prosecution of the instant application are incorporated by reference in their entirety herein.

Based upon at least the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: /C.W. Mueller/
Craig W. Mueller
Registration No. 52,055
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: November 15, 2008